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(For Patent Owner)

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(For Requester)

In re reissue application of
Robert Ainsworth, et al.
Application No. 09/143,503
Filed: August 28, 1998
For: U.S. Patent No. 5,554,121

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DECISION
SEVERING
MERGER

In re Robert Ainsworth, et al.
Reexamination Proceeding
Control No. 90/004,946
Filed: March 23, 1998
For: U.S. Patent No. 5,554,121

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The merged proceeding consisting of reissue application 09/143,503 and ex parte reexamination proceeding 90/004,946 is before the Office for issuance of a decision to sua sponte sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the ex parte reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,554,121 (the '121 patent) issued September 10, 1996.
2. On April 9, 1997, a request for ex parte reexamination of the '121 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number

90/004,602. A first reexamination certificate issued on July 14, 1998 confirming claims 1-6 and adding new claims 7-17.

3. On March 23, 1998, a request for ex parte reexamination of the '121 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 90/004,946 (the '946 reexamination proceeding).

4. On June 8, 1998, reexamination was ordered for the '946 reexamination proceeding.

5. On August 28, 1998, the patent owner filed a reissue application based on the '121 patent, which was assigned Application Number 09/143,503 (the '503 reissue application).

6. In a merger decision mailed November 15, 1998, the Office merged the '503 reissue application and the '946 reexamination proceeding into a single combined proceeding. The reissue application and the reexamination file were then remanded to the Director of Examining Group 3700 for examination in accordance with the merger decision.

7. The merged proceeding of the '503 reissue application and the '946 reexamination proceeding progressed to the point where, on January 30, 2009, a non-final office action was mailed. The time for response expired on July 31, 2009 and no response has been received from the patent owner.

DECISION

At page 5 of the merger decision mailed November 15, 2000, it was stated:

"If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings."

In this instance, the patent owner failed to file a timely and appropriate response to the non-final Office action of January 30, 2009. Accordingly, the merged proceeding of the '503 reissue application and the '946 reexamination proceeding is hereby dissolved and severed into two separate proceedings.

The '503 reissue application and the '946 reexamination proceeding are forwarded to Technology Center 3700, for action as follows:

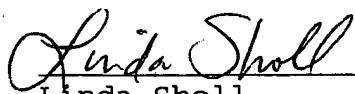
The reissue application will be held abandoned.

The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings.

If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination will be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) will be applied by the examiner. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution will be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

CONCLUSION

1. The merged proceeding consisting of '503 reissue application and the '946 *ex parte* reexamination proceeding is hereby severed into (1) a separate proceeding, for the '503 reissue application, for reissue of the '121 patent, and (2) a separate proceeding, the '946 *ex parte* reexamination, for reexamination of the '121 patent. The two proceedings will be addressed separately and concurrently.
2. Jurisdiction over the '503 reissue application proceeding and the '946 reexamination proceeding is returned to the examiner in Technology Center 3700 for immediate action on the proceedings, toward resolution of the proceedings, and not inconsistent with this decision.
3. Telephone inquiries related to this decision should be directed to Linda Sholl, Special Program Examiner, at (571) 272-4391.



Linda Sholl
Special Program Examiner
Technology Center 3700